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10/789,989

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EXAMINER

PATEL, AJIT

ART UNIT

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2616

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|------------------------------------------|--|
| Office Action Summary | Application No. 10/789,989 | Applicant(s) VERBESSELT ET AL. | |
| | Examiner AJIT G. PATEL | Art Unit 2616 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-20 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-20 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/206,290.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 14-20,25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,2,8,13,24 and 26 of U.S. Patent No. 6,771,658. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claim is broaden in every aspect than the patent claim and is therefore an obvious variant thereof. The following is the comparison between the claim in the instant application and the patent claim.

Regarding claim 14, the predetermined terminal comprises ATM signaling --- over the local area network is the same as the connection set-up request --- an ATM signaling protocol as in claims 1,2,8,12.Regarding claim 15, the recitation "the ATM signaling protocol means ---for releasing said connection" is the same as whereby upon receipt of said connection set-up request --- said network termination apparatus as in claims 1,2,8,12. Same rejection applies to claims 16-20. For claim 25, the recitation "said

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second conversion means is further --- to said ATM network” is the same as the recitation “said conversion means ---an ATM signaling protocol” recited in claim 24 and 26.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14-20,25 are rejected under 35 U.S.C. 102(b) as being anticipated by lidaka et al (U.S. Pat. # 5,528,590).

Regarding claim 14, lidaka et al disclose the communication between ATM and LAN comprising the predetermined terminal comprises ATM signaling protocol means adapted to terminate an ATM signaling protocol received over the local area network (lines 42-62, col. 5 which imply that the ATM signaling protocol is terminate an ATM signaling protocol)

Regarding claim 15, lidaka et al disclose the limitation “ATM signaling protocol means is further adapted to, upon receipt of a connection setup request local area network message, for setting up, or releasing, a connection between a first terminal connected to a local area network and a second terminal connected to an ATM network, to generate and transmit at least one ATM message of the ATM signaling protocol for setting up or releasing said connection” (lines 45-62, col. 5).

Regarding claim 16, lidaka et al disclose the limitation "said predetermined terminal further comprises third connection request means coupled to the ATM

signaling protocol means and adapted to generate a connection setup request message or a connection release request message, for requesting to setup or to release a connection between said predetermined terminal and a second terminal connected to an ATM network, said ATM signaling protocol means thereby being adapted to generate and transmit at least one ATM message of said ATM signaling protocol for setting up or for releasing said connection upon receipt of said connection setup request message or said connection release request message (lines 1-47, col. 8).

Regarding claim 17, Iidaka et al disclose the limitation "said ATM signaling protocol means is further adapted to generate upon receipt of at least one corresponding local area network message being at least one converted ATM message of said ATM signaling protocol for setting up or for releasing a connection between a first terminal connected to said local area network and a second terminal connected to said ATM network, at least one next ATM message of said ATM signaling protocol for setting up or for releasing said connection (lines 45-62, col. 5).

Regarding claim 18, Iidaka disclose the limitation "said ATM signaling protocol means is further adapted to generate upon receipt of at least one ATM message of said ATM signaling protocol for setting up or releasing a connection between a first terminal connected to said local area network and a second terminal connected to said ATM network, at least one next ATM message of said ATM signaling protocol for setting up or releasing said connection (lines 45-62, col. 5)

Regarding claim 19, Iidaka et al disclose "said predetermined terminal comprises first conversion means coupled between said ATM signaling protocol means and said local area network interface means and adapted to receive and to convert at least one ATM message generated by said ATM signaling protocol means to at least one corresponding local area network message for further transmission via local area network interface means to said network termination means (lines 1-47, col. 8).

Regarding claim 20, Iidaka et al disclose "said first conversion means is further adapted to convert local area network messages received from said local area network interface means into corresponding ATM message for delivery to said ATM signaling protocol means.(47, 56 of fig. 1).

Regarding claim 25, Iidaka et al disclose "said second conversion means further adapted to distinguished amongst incoming local area network messages, at least one local area network message being at least one converted message of an ATM signaling protocol for setting up or for releasing a connection between a terminal connected to said local area network and a second terminal connected to said ATM network to reconvert said at least one local network message into at least one ATM message of said ATM signaling protocol for setting up or releasing said connection for further forwarding to said ATM network (70 of fig. 2).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AJIT G. PATEL whose telephone number is 571-272-3140. The examiner can normally be reached on MONDAY- FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris TO can be reached on 571-272-7629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/AJIT G. PATEL/
Primary Examiner, Art Unit 2616